

**REMARKS**

Claims 1, 3-11, 13, 15-17, 19, 20 and 22-25 are all the claims pending in the application. Claims 20, 23 and 24 are rejected. Applicant thanks the Examiner for indicating that claims 1, 3-11, 13, 15-17, 19, 22 and 25 are allowed.

**35 U.S.C. §103:**

Claims 20, 23 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Field et al. (U.S. Patent 6,304,699 [hereinafter "Field"]).

As an initial matter, Applicant respectfully submits that the rejection is unclear on its face for not containing the proper contents of a 35 U.S.C. §103 rejection. This is because in order to make a proper 35 U.S.C. §103 rejection, MPEP §706.02(j) requires the Examiner to set forth the following:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page numbers and line numbers, where appropriate,
- (B) the difference or differences in the claim over the applied references,
- (C) the proposed modification of the applied references necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

In this case, the rejection does not at least 1) set forth the difference or differences in the claims over the applied references; 2) present any sort of proposed modification; or 3) explain why one of ordinary skill in the art, at the time of the invention, would have been motivated to make a modification. Thus, for at least these reasons the rejection is improper and should be withdrawn.

The Action does include a "note" at the bottom of page 1, which refers to an alleged motivation to use various materials disclosed in the specification. However, the claims do not explicitly recite any of these materials, nor are the claims limited to these materials. Plus, any motivation to use these materials in Field would clearly be based on hindsight and not the teachings of the applied art, for it is the present inventor who proposed the idea of using such materials to derive the claimed structure, and not the prior art.

Turning to the grounds of the rejection, the Examiner alleges that Field discloses an outer protective sheath formed from a wound piece of composite material, as shown in Fig. 1. In particular, it is alleged that such a sheath is a combination of elements 36 (jacket), 34 (tape), 52 (resin) and 54 (water absorptive substance). For the claimed stacks, the Examiner relies on elements 26 and 22.

Applicant respectfully traverses the rejection in view of the following remarks.

Rejections under 35 U.S.C. §103(a) are proper only when the applied reference would have taught or suggested each feature recited in the claims. Field would not have taught or suggested each feature recited in claims 20, 23 and 24.

*Claim 20*

Claim 20 recites, *inter alia* “an outermost protective sheath formed from a piece of tape, said tape made of a wound piece of composite material.” Field would have failed to teach or suggest this feature because it does not disclose at least the claimed outermost protective sheath along with its novel and unobvious description of material. If one skilled in the art were to identify the element of Field which is the “outermost protective sheath,” they would have picked element 36. This is because element 36 is the outermost element and is disclosed as being a cable jacket. Further, if one skilled in the art were to have identified the element of Fig. 1 which is considered to be “tape,” they would have picked element 34. This is because element 34 is disclosed as being tape (see col. 3, lines 33 and 34). However, the disclosed tape 34 does not form an “outermost protective sheath.” Instead, the tape 34 is positioned beneath element 36, and would not have been considered to be an “outermost” element. Thus, the inclusion of element 34 against the claimed tape is improper for at least this reason.

It is also improper for the Examiner to apply the combination of elements 34, 36, 52 and 54 against the claimed tape. This is because the combination of these elements would not have disclosed the claimed “tape,” nor would one skilled in the art have equated such a combination to the claimed tape. Instead, these are separate elements which are disposed such that the tape 34 is positioned inside of the separate element 36. Accordingly, Applicant respectfully submits that Field would not have taught or suggested each feature recited in claim 20.

*Claim 23*

Field also would have failed to teach or suggest each feature recited in claim 23. In particular, claim 23 recites, *inert alia*, the deposition of an optical fiber directly on said tape made from a composite material. The Examiner applies the water blocking formulation 50 and the core tube 94 against the claimed tape. Elements 50 and 94 are shown in Fig. 7. First of all, neither of elements 50 and 94 is disclosed as being “tape.” Instead, element 50 is the water blocking formulation (see col. 3, line 47) and element 94 is disclosed as being a core tube (see col. 7, line 17). However, the term “tape” is not associated with any of these elements. Instead, it is clear that when Field choose to disclose “tape,” it was done so by explicitly using the word “tape” as used to describe element 34 (see col. 3, lines 33 and 34). Thus, the combination of elements 50 and 94 would not have taught the claimed tape, let alone the claimed novel and unobvious tape that is made from a composite material.

Further, claim 23 also describes “applying gel to a first side of said tape.” The Examiner applies resin 52 against the claimed gel. The resin can be seen in Fig. 3. It is important to note that element 50 (applied against the claimed tape) is made of the resin 52 and the water absorbing substance 54. Thus, it is nonsensical to submit that the resin 52 is “applied to” element 50, because the resin 52 is already a part of element 50.

Furthermore, claim 23 recites “rolling said tape to form a buffer tube.” There is no disclosure of rolling either element 50 or 94, which are applied against the claim tape. Instead, the water blocking formulation 50 is disclosed as being “applied” to the core tube 94 (see col. 7, lines 20 and 21). As one skilled in the art would have appreciated, the disclosure of “applying”

would not have taught the recited feature of “rolling.” Furthermore, one would not have been taught that the core tube 94 is formed by rolling in light of Field’s disclosure. Accordingly, Applicant respectfully submits that Field would have failed to teach or suggest each feature recited in claim 23.

*Claim 24*

Claim 24 defines, *inter alia*, an “axial member which is centrally positioned with respect to said outer protective sheath, and is formed from a wound piece of composite tape.” The Examiner applies element 21 of Field against the claimed axial member. However, there is no teaching or suggestion of this element as being a wound piece of composite tape. The Examiner also appears to recognize this by neglecting to even make such an assertion. Instead, element 21 is disclosed as being a “dielectric central member.” One clearly would not have been taught or suggested the claimed axial member formed from a wound piece of composite tape by the mere disclosure of the dielectric member in Field. Thus, Applicant respectfully submits that Field would have failed to teach or suggest each feature recited in claim 24.

In view of the preceding remarks, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephonic interview, he is kindly requested to contact the undersigned attorney at the local telephone number listed below.

REQUEST FOR RECONSIDERATION  
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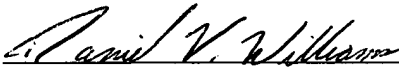
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**23373**

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